



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,701	12/04/2003	Kazushige Hatori	00862.023346.	9227

5514 7590 02/20/2008  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
----------

MCCOMMAS, BRENDAN N

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

02/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/726,701	<b>Applicant(s)</b> HATORI ET AL.	
	<b>Examiner</b> BRENDAN MCCOMMAS	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/24/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Claim Objections**

1. Claims 1, 7, 8, 11-15 is objected to because of the following informalities:
2. Regarding claim 1, examiner suggests deleting the word, "been" before the phrase, "received a print order." In addition examiner suggests deleting the word, "to" after the phrase "to control." Appropriate correction is required.
3. Regarding claim 7, examiner suggests deleting the article, "a" which precedes the phrase "color printing." Appropriate correction is required.
4. Regarding claim 8, examiner suggests deleting the word, "been" before the phrase, "received a print order." Appropriate correction is required.
5. Regarding claim 11, examiner suggests removing the phrase, "to control," which follows the phrase, "unit adapted." Appropriate correction is required.
6. Regarding claim 12, examiner suggests deleting the phrase, "to print."  
Appropriate correction is required.
7. Regarding claim 13, examiner suggests changing the first occurrence of the word "set", to "sets" Appropriate correction is required.
8. Regarding claim 14, examiner suggests deleting the phrase, "to prohibit."  
Appropriate correction is required.
9. Regarding claim 15, examiner suggests deleting the phrase, "to print."  
Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4 and 6-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiba et al. (United States Patent 7,187,459) hereinafter referenced as Chiba in view of Kemp et al. (United States Patent Publication 2002/0078160) hereinafter referenced as Kemp.

3. **Regarding claim 1**, Chiba discloses a printing system in which programs required for printer operations are downloaded from the computer. In addition Chiba discloses a print service apparatus comprising:

4. generation unit 1304 adapted to generate print setting information including a print device ID by which a print device used for previously printing can be identified when said print service apparatus has been received a print order from a user terminal and performed a print service, as disclosed in column 13, lines 26-33 and column 17, lines 27-40 and exhibited in figure 11.

5. display control unit 1122 adapted to control display information related with said print device, as disclosed in column 12, lines 22-33 and exhibited in figure 11.

6. However Chiba fails to explicitly disclose that the display information includes information which identifies the said print device by the ID in a browsing window of the

terminal. However it would have been obvious to one of ordinary skill in the art at the time of the invention to include information which identifies the said print device by the ID in a browsing window of the terminal as taught by Kemp.

7. In a similar field of endeavor, Kemp discloses a computer network. In addition Kemp discloses that the display information includes information which identifies the said print device by the ID in a browsing window of the terminal, as exhibited in figure 6A.

8. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Chiba, that the display information includes information which identifies the said print device by the ID in a browsing window of the terminal for the purpose of allowing the print user to easily view the location of the actual print device from any part of the apparatus.

9. **Regarding claim 2**, Chiba and Kemp disclose everything claimed as applied above (see claim 1) However Chiba fails to explicitly disclose that the print setting information includes information related with a print service provider having said print device. However it would have been obvious to one of ordinary skill in the art at the time of the invention to include information related with a print service provider having the print device in the print setting information as taught by Kemp.

10. In a similar field of endeavor, Kemp discloses a computer network. In addition Kemp discloses that print setting information includes information related with a print service provider having a print device, as disclosed in [0057]-[0059], and [0069].

11. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Chiba, so that print setting information includes information related with a print service provider having a print device for the purpose of allowing the print user to easily view the location of the actual print device from any part of the apparatus.

12. **Regarding claim 3**, Chiba and Kemp disclose everything claimed as applied above (see claim 1). In addition Kemp discloses that the information related with a print service provider contains print service information serving as a printing destination, a printer type capable of print by the print service, or a paper size as disclosed in [0058] and [0069].

13. **Regarding claim 4**, Chiba and Kemp disclose everything claimed as applied above (see claim 1). In addition Kemp discloses that the print setting information includes information related with print conditions set to said print device, as disclosed in [0069].

14. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Chiba, so that print setting information includes information related with print conditions set to said print device for the purpose of alerting the user what to expect the printed copy to look like.

15. **Regarding claim 6**, Chiba and Kemp disclose everything claimed as applied above (see claim 1). In addition Kemp discloses that the apparatus further comprises an:

16. receiving unit 30 adapted to receive a condition for the plurality of print devices, as disclosed in [0023]-[0024] and figure 3; and

17. selecting unit 20 adapted to select the print device based on the received condition, as disclosed in [0070], [0086] and disclosed in figure 3.

18. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Chiba, to have a receiving unit adapted to receive a condition for the plurality of print devices, and a selecting unit adapted to select the print device based on the received condition for the purpose of quickly choosing a printer over the internet which would match the user's needs.

19. **Regarding claim 7**, Chiba and Kemp disclose everything claimed as applied above (see claim 6). In addition Kemp discloses that the apparatus wherein the conditions for selecting the device are that the device can print color print data which is stored with the user preferences, and the selecting unit selects the appropriate print device based on these choices, such as a color photo only printer, as disclosed in [0004], [0069] and [0086].

20. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Chiba, to have the condition for selecting the print device depend upon whether or not the device is a color printer for the purpose of quickly choosing a printer over the internet which could print color data.

21. **Regarding claim 8**, Chiba and Kemp disclose everything claimed as applied above (see claim 6). In addition claim 8 is interpreted and rejected for the reasons set

forth in the rejection of claim 1. Claim 1 describes an apparatus, and claim 8 describes the specific method used to implement the apparatus. Thus claim 8 is rejected.

22. **Regarding claim 9**, Chiba and Kemp disclose everything claimed as applied above (see claim 8). In addition Chiba discloses the program for controlling a print service apparatus according to claim 8, as disclosed in column 4, lines 51-56.

23. **Regarding claim 10**, Chiba and Kemp disclose everything claimed as applied above (see claim 9). In addition Chiba discloses a storage medium for computer-readably storing a program according to claim 9, as disclosed in column 4, lines 51-56.

24. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiba et al. (United States Patent 7,187,459) hereinafter referenced as Chiba in view of Kemp et al. (United States Patent Publication 2002/0078160) hereinafter referenced as Kemp, further in view of Knapp (U.S. Patent Publication 2003/0197875).

25. **Regarding claim 5**, Chiba and Kemp disclose everything claimed as applied above (see claim 4). However Chiba fails to disclose the apparatus wherein said print conditions include tint. However it would have been obvious to one of ordinary skill in the art at the time of the invention to include such a modification to the invention of Chiba, as taught by Knapp.

26. In a similar field of endeavor, Knapp discloses the production of high fidelity copies by consideration of a receiver's characteristics. In addition Knapp discloses that the print setting information which contains print conditions includes tint, as disclosed in [0012].



27. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Chiba, so that print setting information includes information related with the tint of the receiver device for the purpose of alerting the user what to expect the printed copy to look like, and to correct any tinting which is undesired.

28. **Claims 11-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubori et al. (United States Patent 7,283,267) hereinafter referenced as Mitsubori in view of Enomoto (U.S. Patent Publication 2002/0131080).

29. **Regarding claim 11**, Mitsubori discloses a data processing device, data processing method and data processing program for recognizing characters in a URL. In addition Mitsubori discloses a print service system in figure 2 comprising:

30. first judging unit located in the scanner 18 adapted to judge whether or not a content to be printed is color data, as disclosed in column 16, lines 40-50; and

31. print control unit located in the scanner 18 adapted to print the content using a print device of a plurality of print devices (40 a-c) when said first judging unit judges that the content is color, as disclosed in column 16, lines 40-50.

32. **Regarding claim 12**, Mitsubori discloses everything claimed as applied above (see claim 11). However Mitsubori fails to explicitly disclose the system further comprising a second judging unit adapted to judge whether or not a print order is reorder, wherein said print control unit controls to print the content using the same print device as used at a previous print order when a result of judging is reorder. However it

Art Unit: 2625

would have been obvious to one of ordinary skill in the art to include such a modification to Mitsubori, as disclosed in Enomoto.

33. In a similar field of endeavor, Enomoto discloses a print system. In addition Enomoto discloses that his print system further includes a second judging unit adapted to judge whether or not a print order is reorder, wherein said print control unit controls to print the content using the same print device as used at a previous print order when a result of judging is reorder, as disclosed in [0040].

34. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Mitsuboro, to include a second judging unit adapted to judge whether or not a print order is reorder, wherein said print control unit controls to print the content using the same print device as used at a previous print order when a result of judging is reorder for the purpose of allowing the process to proceed more quickly.

35. **Regarding claim 13**, Mitsubori and Enomoto disclose everything claimed as applied above (see claims 12 and 5). However Mitsubori and Enomoto fail to explicitly disclose the system wherein said print control unit sets the same tint as was set in a previous print order to the same print device. However, the examiner takes official notice of the fact that it was well known in the art to provide the system wherein said print control unit sets the same tint as was set in a previous print order to the same print device.

36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mistuboro and Enomoto by specifically providing

the system wherein said print control unit sets the same tint as was set in a previous print order to the same print device, for the purpose of allowing the process to proceed more quickly.

37. **Regarding claim 14**, Mitsubori discloses everything claimed as applied above (see claim 11). In addition Mitsubori discloses a prohibiting unit adapted to prohibit a print device to be used in accordance with an instruction of a user, as disclosed in column 6, lines 55-65.

38. **Regarding claim 15**, Mitsubori discloses everything claimed as applied above (see claim 11). In addition claim 15 is interpreted and rejected for the reasons set forth in the rejection of claim 11. Claim 11 describes an apparatus, and claim 15 describes the specific method used to implement the apparatus. Thus claim 15 is rejected.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENDAN MCCOMMAS whose telephone number is (571)270-3575. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Brendan N. McCommas/  
Examiner, Art Unit 2625

/B. M./

Examiner, Art Unit 2625

/Jefferey F Harold/

Supervisory Patent Examiner, Art Unit ~~4115~~ 4115